

REMARKS

Claims 1 through 21 are currently pending in the application. In response to the Office Action of September 22, 2004, claims 1, 2, 6 through 16, 18 , 19 and 21 have been amended. Care has been taken to avoid the introduction of new matter. Favorable reconsideration of the application as now amended is respectfully solicited.

Claims 1, 8 through 11 and 13 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,433,530 (Pool). The Office Action describes the Pool device as having circuitry configured to sense a low automotive system voltage and a high automotive system voltage.

In response to the rejection, independent claim 1 has been amended to require, *inter alia*, the following:

A handheld circuit tester for an automotive electrical system having circuit portions respectively operable at a first nominal voltage range with respect to ground and a second nominal voltage range with respect to ground, the tester comprising:

circuitry disposed within the handle portion and operatively coupled to the probe device and the ground device, the circuitry being configured to sense voltage at the circuit point and to indicate whether the sensed voltage corresponds to the first or second nominal voltage range.

Claims 2, 6, 7, 10 and 11 have been amended to be consistent with now amended claim 1 and to clarify minor errors discovered upon review of the claims. Independent method claim 13 has been amended in a manner similar to claim 1 and requires first and second nominal operational voltage levels and identification thereof when performing a test of a circuit point.

Pool discloses a circuit testing device that activates a light bulb indicative of continuity between the probe test point and the clamped circuit point and a polarity indicating buzzer. Pool

does not disclose use of the tester in a system respective portions of which are operable in two nominal voltage ranges. There is no provision in the Pool device, nor any suggestion, of an indication that a sensed voltage corresponds to one of two nominal operational voltage ranges. It is submitted, therefore, that claims 1, 8 through 11 and 13 are not anticipated by Pool. Withdrawal of the rejection is respectfully solicited.

Claims 2 through 7, 12 and 14 through 21 have been rejected under 35 U. S. C. § 103(a) as being unpatentable over Pool in view of U.S. patent 5,789,911 (Brass). The Office Action asserts that Pool discloses “everything except [a first] indicator that indicates a low automotive system voltage is sensed, and a second visible indicator that indicates a high automotive system voltage is sensed.” Brass has been relied upon for concluding that it would have been obvious “to have different indicators within the handheld testing device for the purpose of easier to recognize two different voltage level [sic].” Reconsideration is respectfully requested.

Legal precedent is well developed with respect to 35 U.S.C. §103. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for: (1) claim features; and (2) the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). This burden is not met if there is no showing that the combination of references would actually meet all the limitations of the claims under consideration.

An Office Action rejection must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The examiner should recognize that even if the prior art *could* be modified so as to result in the combination defined by the claims the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

What may or may not be known in general does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). The requisite motivation is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). The question is not what one having ordinary skill in the art could or could not do, but: *why* would one having ordinary skill in the art have been realistically impelled to deviate from the express teachings of the prior art to arrive at the claimed invention? *Gentry Gallery v. Berkline*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is submitted that the rationale stated in the Office Action for concluding obviousness is not sufficient to meet the above legal criteria. Brass is directed to a polarity testing device in which one LED is activated for a first test polarity and a second LED is activated for the opposite test polarity. There is no teaching in Brass of providing an indication of whether a test voltage corresponds to a first or second nominal voltage range with respect to ground, as required by each of the claims under rejection. Brass instead is concerned with indication of the polarity of the voltage at the circuit test point. At most, a person of ordinary skill in the art might have found a suggestion for providing a visual polarity identification in Pool in lieu of, or in addition to, the buzzer. As neither reference teaches operation at a plurality of nominal voltage levels, there is no viable reason to conclude that an artisan would have been impelled by the combined reference teachings to further modify Pool to provide nominal voltage level identification.

The Office Action is silent as to the circuit requirements recited in claims 12 and 20. Each of these claims requires two zener diodes having respective breakdown voltages for appropriately activating the recited visual indicators. Neither Pool nor Brass discloses or suggests such features.

Accordingly, it is submitted that all rejections have been overcome. Allowance of the application is respectfully solicited. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with

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the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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